

REMARKS

This is a full and timely response to the final Official Action mailed September 9, 2004. Reconsideration of the application in light of the above amendment and the following remarks is respectfully requested. Claims 1, 3 and 6–10 have been rejected; claim 5 has been allowed and claims 2, 4 and 11 have been objected to as being dependent on a rejected base claim. Applicant wishes to thank Examiner for the indication of allowable subject matter of claims 2, 4, 5 and 11. By the foregoing amendment claims 12 and 13 have been added. Thus, claims 1–13 are pending in the present application. New claims 12 and 13 contain no new matter and are supported by the original claims, as well as the original specification. Previously presented claim 11 has been rewritten as currently amended claim 11 and new claim 12 for clarification purposes. Applicant respectfully traverses all rejections.

The Examiner granted a telephone interview regarding this application on October 21, 2004. Applicants wish to thank the Examiner for the Interview. The substance of that Interview is reflected in the amendment and remarks below. In the interview, the Examiner indicated there may be a new basis for rejection of claim 5 and will reconsider the claim. Applicant awaits Examiner's action with regards to claim 5. Applicant has also added claim 13 in response to Examiner's suggestion during the interview that reciting some type of resultant characteristic or property is likely to contain allowable subject matter.

Rejection – 35 U.S.C. § 103

The Office has rejected claims 1, 3 and 6–10 under 35 U.S.C. § 103(a) as being unpatentable over Admitted Prior Art (APA) or EP '017 in view of Yang et al. and Hawtof et al. In particular, the Office rejected the claims because "it would have been obvious to one of ordinary skill in the art to construct or provide the buffer tubes of the APA or EP '017 out of an alloy of polypropylene and polyphenylene oxide in view of the teachings of Yang et al. and

Hawtof et al.” Office Action, page 2, paragraph 2. The Office asserts that Yang et al. provides the suggestion or motivation to combine the references, which is to “us[e] an alloy of different polymers as materials for buffer tube construction to provide better mechanical and electrical properties.” Office Action, pages 2–3, paragraph 2. Applicant respectfully traverses the rejections.

The Office has not established a prima facie case of obviousness for any of the rejected claims because it has not provided a proper motivation to combine references. In particular, the Office’s combination of Yang et al. with Hawtof et al. is improper because (1) Hawtof et al. is not analogous art, (2) the combination changes the principle of operation of Yang et al., (3) the Office’s alleged motivation in Yang et al. does not suggest the desirability of combining PPO with PP for use in a buffer tube, and (4) the Office’s combination is an impermissible use of hindsight reconstruction from Applicant’s disclosure.

First, Hawtof et al. is not analogous prior art because it is not “in the field of applicant’s endeavor” and is not “reasonably pertinent to the particular problem with which the inventor was concerned.” M.P.E.P. 2141.01(a). Applicant’s originally filed specification indicates that the application is “relate[d] to buffer tubes for optical fiber cables.” See Specification, paragraph 1. Hawtof et al., on the other hand, is directed to a means of identifying optical fibers by coating individual optical fibers with a coating that “includes material forming a data storage medium which is capable of digitally encoding information.” Col. 1, line 66 – col. 2, line 4. It is also directed to methods of digitally encoding information onto and retrieving information from an optical fiber. See col. 1, lines 15-43. The Office has not shown that Hawtof et al. discloses anything relating to buffer tubes for optical fiber cables, and thus has not shown that Hawtof is analogous prior art.

Second, the combination of Hawtof et al. with Yang et al. was improper because the combination changes the principle of operation of Yang et al. “If the proposed modification

or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” M.P.E.P. 2143.01. Yang et al. is directed to overcoming shrinkage and compression-tension problems in PP-PE copolymer buffer tubes by adding a nucleating agent or filler material to the PP-PE copolymer. See col. 2, lines 19–36. The nucleating agents include inorganic materials, salts of aliphatic monobasic or dibasic acids, aralkyl acids, or alkali metal or aluminum salts of aromatic or alicyclic carboxylic acids. The filler materials include talc, glass fiber and glass spheres. The combination of Hawtof et al. with Yang et al. operates by changing the buffer tube copolymer rather than by introducing a nucleating agent or filler material to a PP-PE copolymer. Since the principle of operation of Yang et al. is to overcome the mechanical disadvantages of PP-PE by including nucleating agents or filler materials, the Office’s combination changes the principle of operation of Yang et al.


Third, the Office has not shown that the teachings of Yang et al. and Hawtof et al. suggest to one of ordinary skill in the art the desirability of the Office’s combination. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” M.P.E.P. 2143.01; see *In re Mills*, 916 F.2d 680, 16 USPQ2d 1420 (Fed. Cir. 1990);. It is well established that even if all elements of a claim are disclosed in the prior art, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill would have been prompted to combine the teachings of the prior art to arrive at the claimed invention. In particular, the Office has not provided a showing in the prior art that would suggest combining PPO with a PP-PE copolymer to provide better mechanical and electrical properties of buffer tubes.

Finally, the Office's combination is an impermissible use of hindsight reconstruction from Applicant's disclosure. See, e.g., *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." See, e.g., *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). The Hawtof et al. reference to the use of PPO is an isolated disclosure that has been improperly combined with Yang et al. through hindsight reconstruction from Applicant's disclosure.

CONCLUSION

Since none of the references, alone or in combination, disclose or make obvious the invention as now claimed, Applicant respectfully requests the Office to withdraw the pending grounds of rejection and allow the pending claims. If there is any fee due in connection with the filing of this Request for Reconsideration, including a fee for any extension of time not accounted for above, please charge the fee to our Deposit Account No. 18-0013/64671-0480.

Respectfully Submitted,

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